

REMARKS

These remarks are responsive to the final Office Action of January 14, 2004. Claims 1-30 are pending. Reconsideration and allowance of the instant application are respectfully requested.

Claims 2, 7, 8 and 27-29

The Office Action relies on U.S. Patent No. 6,335,727 to Morishita et al. (hereinafter referred to as Morishita) to reject claims 2, 7, 8 and 27-29 under 35 U.S.C. § 102(e).

With regard to claims 2, 7, and 8, the Office Action alleges that Morishita's first and second modes (shown in FIGS. 44A and 44B) equate to the recited classifying step. (See Office Action ¶5). Further, the Office Action discusses the first and second modes of Morishita at pg. 9, e.g., "the electronic ink can be used in different modes" and the "electronic ink is classified as ink for writing, and when the device is used for erasing, the electronic is classified as electronic ink." For claims 2, 7, 8 and dependent claims 27-29, it is respectfully asserted that Morishita **fails** to disclose a method for adding electronic ink to displayed information on a system having a display with an implementation of classifying the electronic ink as recited. Applicants point out that "[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997).

With regard to claim 2, the Office Action alleges that Morishita teaches classifying electronic ink as embedded ink or overlaid ink. (See Office Action ¶5, and pg. 10). It is respectfully asserted that Morishita **fails** to disclose associating the electronic ink with at least

one object of the displayed information wherein the classifying step includes classifying electronic ink as one of **embedded ink and overlaid ink**.

As set forth in claim 2, the recited electronic ink is added to the displayed information and is classified as embedded ink or overlaid ink. In clear contrast, the alleged embedded ink described in Morishita refers to "special ink" located within the information writing section 11 of the so-called information input device 10. In particular, Morishita states that "[w]hen the surface of the position information holding device 25 is colored in white by special optical coating, and a **writing section using a special ink is embedded in the information writing section 11**, a writing operation can be performed using the position information holding device 25 itself as a writing medium 29 (display device) without using paper." (Emphasis added) (Morishita, col. 30, lines 64-67 to col. 31, lines 1-3). In the recited embedded ink of claim 2, the electronic ink is classified after being added to the information display as part of the association with at least one object. Thus, Morishita does not have the recited provision. Further, Morishita's eraser mode embodiment merely relates to making an erasing region, there is no teaching or suggesting of receiving added electronic and classifying the added electronic ink as overlaid ink or embedded ink. (See col. 20, lines 20-41). "Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. . . . **There must be no difference between the claimed invention and the reference disclosure.**" *Scripps Clinic & Research Found. v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)(emphasis added). Clearly, Morishita fails to teach each and every feature of claim 2 and there are a number of differences. Thus, claim 2 is allowable for at least any one of the foregoing reasons.

Claim 7

With regard to claim 7, the Office Action alleges that Morishita teaches the recited anchoring step. It is respectfully asserted that Morishita fails to teach or suggest associating the electronic ink with at least one object of the displayed information wherein **said associating step further includes the step of: anchoring said electronic ink to said at least one object by adding a link at or near said object pointing to said electronic ink.**

The Office Action asserts that the closed curve being near the search region is sufficiently similar to claim 7 to sustain the rejection under 35 U.S.C. § 102(e). (See Office Action ¶ 5). There is no teaching of anchoring, nor a teaching of adding the recited link. Sufficiently similar is not the legal standard for anticipation. Applicants respectfully request the Patent Office apply the correct legal standard to claim 7. “[F]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art.” *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Claim 7 is allowable and the rejection under 35 U.S.C. § 102(e) is improper and must be withdrawn.

Claim 8

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph. Among other features claim 8 recites, “the relationship of said electronic ink to said at least one object is maintained despite re-flowing of said displayed information by a layout engine.” The re-flow concept is supported at least on pages 26-28 and shown in FIGS. 14-16 of the instant application. For example, in one embodiment, as shown in Figure 14 on page 1401, ink 1403 anchored to a single

position in an in-line flow, and not in a margin, re-positions and re-scales along with the element immediately preceding or following the anchor. With respect to Figure 14, the outline 1403 on page 1401 continues to outline the text 'in-line' as 1404 on page 1402 despite the re-flow of text between the two pages, due to at least in part on the change in font size. Thus, the displayed information is re-flowed and the relationship of said electronic ink to said least one object is maintained. Applicants respectfully request withdrawal of the rejection.

The Office Action alleges that Morishita shows that electronic ink may be maintained despite having other information. It is respectfully asserted that Morishita is **completely devoid** of a concept **re-flowing** displayed information including an object and maintaining the relationship of the added electronic ink with the object. Further, there is no layout engine. "Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. . . . **There must be no difference between the claimed invention and the reference disclosure.**" *Scripps Clinic & Research Found. v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)(emphasis added). In view of the foregoing, Morishita fails to teach each and every feature of claim 8 as recited. Thus, claim 8 is allowable over Morishita.

Claims 27 and 28

The Office Action relies on Morishita to reject claims 27 and 28 under 35 U.S.C. § 102(e). Applicants respectfully disagree with these rejections. Independent claim 27 recites, among other features, "wherein said processor classifies electronic ink related to signals received from said input, said processor associates said electronic ink to said content, said processor

transforms said electronic ink, and said processor outputs said transformed electronic ink to said output.” Morishita does not disclose a processor that **1) classifies electronic ink and associates electronic ink with the content; 2) transforms the electronic ink; and 3) outputs the transformed electronic ink.** Morishita fails to disclose each and every feature of claim 27. Hence, claim 27 is allowable. Claim 28 depends from claim 27 and is thus allowable for at least the same reasons.

In addition, claim 28 recites that “said processor classifies said electronic ink based as one of embedded ink and overlaid ink.” Morishita does not teach or suggest classifying electronic ink as one of embedded ink and overlaid ink as discussed above with regard to claim 2. Morishita fails to teach each and every feature of claim 28. Hence, claim 28 is allowable.

With regard to claim 29, Morishita fails to teach or suggest the recited features. There is no embedded ink that occupies an in-line flow of the at least one object on the display. Claim 29 is allowable for the reasons of claim 2 and features discussed in the foregoing.

Claims 1 and 3-6, 14-21

The Office Action relies on a proposed combination of Morishita and U.S. Patent No. 6,340,967 (Maxted) to reject claims 1, 3-6, and 14-21 under 35 U.S.C. § 103(a). It is respectfully asserted that Morishita fails to describe a method for adding electronic ink to displayed information on a system having a display with an implementation of classifying the electronic ink based on a shape of said electronic ink; and associating the classified electronic ink with at least one object of the displayed information. The Office Action alleges that Morishita teaches classifying the electronic ink by equating it to “the classifying of first and

second mode...” Office Action, ¶5. Morishita, however, **does not** classify electronic ink, but merely allows a user to designate *a search region within electronic ink*. Further, Morishita does not classify electronic ink based on a shape of an ink stroke. Morishita only makes reference to the selection of a first and second mode in which a user may manually select one of two *selection modes* to specify a search region within a closed curve or a rectangular. Morishita states that FIGS. 44A to 44C “show an example for **searching** designated writing information from the information storing section 13.” (Emphasis added)(Morishita, col. 25, lines 41-58).

Claim 1 further recites among other features “associating said classified electronic ink with at least one object of said displayed information.” The Office Action asserts that Morishita teaches associating electronic ink with at least one object of the displayed information by “searching a written image in a region enclosed within a closed curve...” Office Action, ¶5. However, searching a written image in a region enclosed within a closed curve does not suggest or teach associating electronic ink with at least one object of the displayed information. In fact, Morishita does not suggest associating electronic ink with anything remotely similar to an object of the displayed information. Morishita merely describes a search curve with a selected region on a paper sheet. (See Morishita, col. 25, lines 41-48). Maxted does not make up for the deficiencies of Morishita. Maxted merely allows a user to place edit symbols in a Selection Window 24. There is no teaching, nor any reason of modifying Morishita’s search region embodiment with edit symbols of Maxted for text. It is quite clear that “[t]he mere fact that prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir.

Appln. No. 09/750,288
Reply to Office Action of January 14, 2004

1984)(reversing an obviousness rejection). In view of the foregoing, as clearly held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an *instruction manual or “template” to piece together* the teaching of the prior art ... [o]ne cannot use hindsight construction to pick and choose among isolated disclosures ... to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). (See also M.P.E.P. 2142). Nonetheless, claim 1 is allowable.

Dependent claims 3-6 is allowable in light of the respective independent claim, and for the further distinguishing features recited therein. For example, as to claim 3, Morishita fails to teach or suggest a classifying step that includes the step of “determining its distance to other annotations.” Morishita fails to describe annotations, much less teach or suggest determining a distance to an annotation. There is absolutely no teaching that the alleged width determination of a recorded writing pattern and displayed writing pattern of Morishita describes a recited feature of “determining its distance to other annotations.” (See Morishita, col. 24, lines 46-59). Thus, claim 3 is allowable for at least this reason.

Regarding claim 4, Morishita does not teach or suggest “determining the ratio of said electronic ink height to width.” There is absolutely no teaching that the alleged width determination of a recorded writing pattern and displayed writing pattern of Morishita describes a classifying step which determines the ratio of the electronic ink height to width. Thus, claim 4 is allowable for at least this reason.

Claims 14-21

Independent claim 14 recites among other features “[a] computer readable medium having a program stored thereon,...said program comprising the steps of: classifying said electronic ink based on a shape of the electronic ink; associating said classified electronic ink with at least one object of said displayed information.” It is respectfully submitted that Morishita does not teach or suggest a program comprising the steps of classifying electronic ink based on a shape of the electronic ink and associating the classified electronic ink with at least one object of said displayed information. Thus, claim 14 is allowable for at least the same reasons as claim 1. Claims 15-21 depend from claim 14 and therefore are allowable for the same reasons.

Claim 15 is allowable for at least the same reasons as claim 2 with regard to Morishita **lack of teaching of the classifying step including classifying electronic ink as one of **embedded ink and overlaid ink.****

Claims 16 and 17 are allowable for at least the same reasons as claims 3 and 4, respectively.

Claims 18 and 19 are allowable for at least the same reasons as claim 5 and 6, respectively.

Claim 20 is allowable for at least the same reasons as claim 7 with regard to Morishita **lack of teaching of said associating step further includes the step of: anchoring said electronic ink to said at least one object by adding a link at or near said object pointing to said electronic ink.**

Claim 21 is allowable for at least the same reasons as claim 8 with regard to Morishita lack of teaching of the relationship of said electronic ink to said at least one object is maintained despite re-flowing of said displayed information by a layout engine. There is no layout engine.

Claims 9-13 and 22-26

The Office Action proposes a combination of Morishita, Maxted, and U.S. Patent No. 5,889,523 to Wilcox et al. to reject claims 9-13 and 22-26 under 35 U.S.C § 103(a). When evaluating patentability under 35 U.S.C. § 103(a), all claim features must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed feature that was absent from the reference). With respect to claims 9-13 and 22-26, it is respectfully asserted that the asserted combination of Morishita and Maxted fail to describe a method for adding electronic ink to displayed information on a system having a display with an implementation of classifying the electronic ink based on a shape of said electronic ink and associating the classified electronic ink with at least one object of the displayed information. Thus, claims 9-13 and 22-26 are allowable for at least the reasons of claim 1. Further, Wilcox fails to teach the noted claimed features.

With regard to claims 9 and 22, the concept of in-line words is at least discussed on page 24 and shown in FIG. 13 of the instant application. For example as shown FIG. 13, the words 'This ink's in-line with text' 1305 were inserted into the flow of the text. Wilcox fails to teach "said classifying step classifies said ink as in-line words in which said at least one object is

Appln. No. 09/750,288
Reply to Office Action of January 14, 2004

within a flow of text.” The present invention as recited in claim 9 would be not disclosed, even if Morishita and Wilcox were combined.

With regard to claims 10 and 23, the concept of text marks is at least discussed on pages 24 and 25 of the instant application. Wilcox fails to teach “said classifying step classifies said ink as text marks.” The present invention as recited in claim 10 would be not disclosed, even if Morishita and Wilcox were combined.

Claim 30

The Office Action proposes a combination of Morishita, Maxted, and U.S. Patent No. 6,384,815 (Huang) to reject claim 30 under 35 U.S.C § 103(a). Claim 30 depends from claim 1 and recites “wherein said step of classifying including classifying said electronic ink as a chain of strokes and said associating step includes associating a center of said chain of strokes with said at least one object.” Huang adds nothing pertinent to Morishita. It is respectfully asserted that claim 30 is allowable for being dependent on claim 1. Nevertheless, claim 30 is allowable because the references do not teach or suggest the inventive features as recited.

CONCLUSION

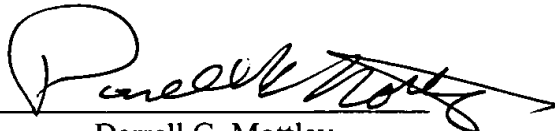
For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in better form for allowance, the Examiner is respectfully urged to contact Applicants’ undersigned representative at the below-listed number. If any additional fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Appln. No. 09/750,288

Reply to Office Action of January 14, 2004

Respectfully submitted,

Date: April 13, 2004

By: 
Darrell G. Mottley
Registration No. 42,912

BANNER & WITCOFF, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001